



UNITED STATES PATENT AND TRADEMARK OFFICE

Handwritten signature

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,994	02/09/2005	Kazunori Tanaka	49677-165	2851

20277 7590 01/06/2006

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

TRAN, HOANG Q

ART UNIT PAPER NUMBER

2874

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/523,994	TANAKA ET AL.	
	Examiner	Art Unit	
	Hoang Tran	2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/09/2005</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent to Newmoyer (5,814,406).

Newmoyer teaches a buffered optical fiber having a second coating layer on an outer peripheral surface of a glass fiber (Fig 1), wherein a second resin composition constituting the second coating layer comprises a base polymer (Col 3 [5-15] and 100 to 250 parts of metal hydroxide and 10 to 100 weight parts of a nitrogen base flame retardant material per 100 weight parts of the base polymer (Col 6 [45-55]), and wherein the second resin composition does not contain halogenated materials (Col 2 [60-65].

As for claims 6-8, Newmoyer teaches the cable of claim 1; the specified limitations of transmission loss, residual thermal distortion and linear expansion

Art Unit: 2874

coefficient are all function properties of the claimed cable of Claim 1. While the features of an apparatus maybe recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (See MPEP 2114) In re Swinehart, 169 USPQ 226 (CCPA 1971); In re Schreiber 44 USPQ2d 1429 (Fed. Cir. 1997)..

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newmoyer in view of the US Patent Application Publication to Ono (2003/0158309).

With respect to claim 2 and 3, Newmoyer teaches the buffer fiber cable of claim 1, Newmoyer does not teach the base polymer is constituted of a non-crystalline resin

Art Unit: 2874

and wherein the base polymer comprises one of the components selected from the group consisting of a polystyrene, polystyrene-base elastomer, a mixture of the base elastomer and polyphenylene ether polymer. Ono does teach a composition comprises of a non-crystalline resin and polyphenylene ether composition (Page 12 [0153]) to enhance optical properties of the buffer fiber cable. A motivation for such an application would be to increase mechanical durability of the cable as well as enhance the optical and electrical properties of the cable. It would have been obvious at the time of the invention to one of ordinary skill in the art to apply the teachings of Ono to the buffer fiber cable of Newmoyer in order to produce a fiber cable with superior mechanical and optical properties.

With respect to claim 4, Newmoyer teaches the buffer cable of claim 1, as stated in the above rejection; Newmoyer in combination with Ono teaches the buffer cable of claim 3. The examiner identifies claim 4 as a product by process claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Once the examiner provides a rationale which supports the conclusion that the claimed product appears to be the same or similar to that of the prior art (See rejection 2 and 3), although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.

Claims 5 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the US Patent to Newmoyer (5,814,406).

Art Unit: 2874

With respect to claim 5, 10, and 11 Newmoyer teaches the optical fiber of claim 1, Newmoyer does not teach the cable wherein the second coating layer is formed of two or more coating sub layers. It would have been obvious to one having ordinary skill in the art at the time of the inventions was made to apply the coating of Newmoyer second layer and duplication into a plurality of layers to manufacture a more durable fiber (See Claim 1 rejection). A motivation to manufacture a duplication of the second layer would be to increase further the mechanical protection of the fiber and prevent internal cracking. Since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v Bemis Co.*, 193 USPQ 8.

With respect to claim 9 and 12, Newmoyer teaches the buffered cable of claim 1. The examiner identifies Claim 9 as Product-by-Process claim since it draws onto a method of making the buffer cable of Claim 1 through a cutting, drawing, and curing process. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Once the examiner provides a rationale which supports the conclusion that the claimed product appears to be the same or similar to that of the prior art (See rejection to Claim 1 and 5), although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.

Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newmoyer in view of the US Patent Application Publication to Caveney (2003/0128938A1).

Newmoyer teaches a buffered optical fiber having a second coating layer on an outer peripheral surface of a glass fiber (Fig 1), wherein a second resin composition constituting the second coating layer comprises a base polymer (Col 3 [5-15] and 100 to 250 parts of metal hydroxide and 10 to 100 weight parts of a nitrogen base flame retardant material per 100 weight parts of the base polymer (Col 6 [45-55]), and wherein the second resin composition does not contain halogenated materials (Col 2 [60-65]. Newmoyer does not teach the buffer cable being connected to a ferrule connector wherein the coating end surface abuts against and abutting end surface of said ferrule. Caveney does teach a fiber cable wherein the end surface abuts against the ferrule connector (Fig 3) in order to couple a fiber optical cable to a connector. A motivation for this application would be to allow the buffered cable to interface with other external optical components within and optical system in a manner, which would limit loss and still maintain reasonable mechanical durability between the ferrule connector and the buffer fiber cable. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Caveney to Newmoyer optical cable in order to couple optical transmission to an external component efficiently.

Conclusion


Art Unit: 2874


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang Tran whose telephone number is 571-272-5049. The examiner can normally be reached on 9:00AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on 571-272-2344. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ht


Hoang Tran
AU 2874
January 4, 2006


SUNG PAK
PRIMARY EXAMINER